

REMARKS

Applicants note that the Examiner has acknowledged Applicants' election of the invention of Group II (claims 18 and 41) in Paper No. 12, filed on December 4, 2002. Accordingly, the Examiner has withdrawn claims 38-40 and 42-45 as being drawn to non-elected inventions.

Applicants have herein cancelled claims 38-40 and 42-45 without prejudice or disclaimer of the subject matter therein. Applicants reserve the right to pursue the inventions claimed therein in future applications.

Claims 18 and 41 are currently pending in this application. Claims 18 and 41 have been amended, and claims 46-85 have been newly added. Support for the newly added claims can be found throughout the application as filed. Specifically, support for the newly added claims can be found at page 7, lines 12-13, page 8, lines 2-5, page 12, lines 22-26, page 16, lines 29-31, and page 17, lines 9-12. It is submitted that no new matter has been added.

I. Amendments to the Specification

(a) The Examiner has noted that the specification of the above-referenced application "only lists that this application is a continuation" (Office Action, page 2, section 2a). However, Applicants note that the two Preliminary Amendments filed April 30, 1997 and November 15, 2000, respectively, should have resulted in an amendment to the specification to include the following priority information paragraph following the title:

"This application is a continuation of Ser. No. 08/846,344, filed April 30, 1997 which is a divisional of Ser. No. 08/609,572, filed March 1, 1996."

Since these amendments were apparently not entered, Applicants have amended the specification as suggested by the Examiner (Office Action, page 2, section 2a). Applicants would like to thank the Examiner for pointing out this apparent omission.

(b) The Examiner has alleged that the title of the invention is not "clearly indicative of the invention to which the claims are directed" (Office Action, page 2, section 2b). Applicants have provided a new title that is technically accurate and descriptive of the claimed inventions (see MPEP 37 C.F.R. § 1.72 and MPEP § 606).

(c) The Examiner has noted that on page 5, line 19 of the specification, a reference is made to "claim 11" which was cancelled in a preliminary amendment filed November 16, 2000 (Office Action, page 2, section 2c). Applicants have amended the specification to remove the reference to claim 11 and replace it with the IL-13bc protein disclosure language, as found on page 4, lines 2-15.

(d) The specification has also been amended to correct a minor typographical error on page 6, line 4.

It is submitted that no new matter has been added. With the instant amendments, Applicants aver that all objections to the specification have been overcome. Applicants respectfully request reconsideration of the application in view of these Amendments.

II. Claim Objections

The Examiner has objected to Claims 18 and 41 for reciting non-elected inventions, i.e., SEQ ID NO:2 and fragments thereof (Office Action, page 2, section 3). Applicants have amended claims 18 and 41 to remove any reference to SEQ ID NO:2 and fragments thereof.

With the instant Amendment, Applicants aver that the objections to the claims have been overcome. Applicants respectfully request reconsideration of the application.

III. Rejection under doctrine of obviousness-type double patenting

Claim 41 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,248,714.

Without acquiescing to the propriety of this rejection, Applicants will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) over U.S. Patent No. 6,248,714 upon allowance of claim 41 of the instant application.

IV. Rejection under 35 U.S.C. § 112 first paragraph

Claims 18 and 41 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly not being in possession of the claimed invention.

Specifically, the Examiner has alleged that “claim 18 encompasses any antibody which can bind to any polypeptide or protein and claim 41 encompasses a method of administering an antibody which can bind to any polypeptide or protein. The instant specification, however, does not provide a written description or the guidance to produce an antibody which binds to any epitope which is contained within the recited sequences” (Office Action, page 5, section 5a).

Without acquiescing to the Examiner’s rejection, Applicants have amended claims 18 and 41 to more particularly point out and distinctly claim the subject matter that Applicants regards as their invention. With the instant amendments to the claims, Applicants aver that the rejection under 35 U.S.C. § 112, first paragraph has been

rendered moot. Thus, Applicants respectfully request that this rejection be withdrawn and the application reconsidered.

V. Rejection under 35 U.S.C. § 112 second paragraph

Claims 18 and 41 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite.

The Examiner purports that “claims 18 and 41 are vague and indefinite because the claims recite ‘....specifically reacts with...’, however, it is unclear how does the claimed antibody react with the recited protein” (Office Action, page 6, sections 6a and 6b).

Without acquiescing to the Examiner’s rejection, Applicants have amended claims 18 and 41 to recite, in pertinent part, that the antibody specifically binds with the isolated IL-13bc protein. With the instant amendment to the claims, Applicants believe that this rejection has been rendered moot. Thus, Applicants request that this rejection be withdrawn and the application reconsidered.

VI. Rejection under 35 U.S.C. § 102 (b)

Claim 18 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hopp et al. (U.S. Patent No. 5,011,912).

Specifically the Examiner has alleged that “Hopp et al’s reference anticipates claim 18, because the claim encompasses an antibody which binds to any antigenic peptide including the flag epitope DYKDDDDK which was bound by the antibody disclosed by Hopp et al.” (Office action, page 6, section 7).

To anticipate a claim, a prior art reference must disclose each and every limitation of the claimed invention, either explicitly or inherently. See *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Absence of a claim element from a prior art reference negates anticipation. *Atlas Powder Co. v E. I. du Pont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781, 227 USPQ (BNA) 773, 778 (Fed. Cir. 1985). In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art. See *id.* at 781.

Upon entry of the instant amendment, claim 18 is directed to a composition comprising an antibody which specifically reacts with an isolated IL-13bc protein comprising an amino acid sequence selected from the group consisting of the amino acids sequence of SEQ ID NO:4 and fragments thereof.

Hopp et al. teach providing a murine hybridoma and a monoclonal antibody produced therefrom that can be used in a process for purifying a recombinant fusion protein having the N-terminal identification peptide sequence, DYKDDDDK. Hopp et al. do not teach or suggest an isolated IL-13bc protein, with or without the DYKDDDDK peptide sequence. Since Hopp et al. do not disclose *each and every limitation* of the claimed invention, Hopp et al. do not anticipate Applicants' invention. Thus, this rejection under 35 U.S.C. § 102(b) has been rendered moot.

Applicants aver that the rejection under 35 U.S.C. § 102(b) has been overcome and request that this rejection be withdrawn and the application reconsidered.

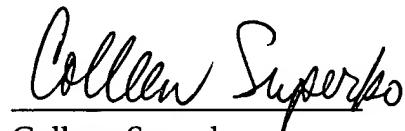
VII. Conclusion

Applicants believe that all of the outstanding rejections of record have been overcome by amendment and/or argument. Accordingly, the claims are now believed to be in condition for allowance. Applicants respectfully request that the Examiner issue a timely Notice of Allowance.

No additional fees are believed to be due in connection with this correspondence, other than the fees for the one month Petition for Extension of Time and excess claim fees. Please charge any payments due or credit any overpayments to our Deposit Account No. 08-0219.

The Examiner is invited to telephone the undersigned at the telephone number given below in order to expedite the prosecution of the instant application.

Respectfully submitted,


Colleen Superko
Reg. No. 39,850

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HALE AND DORR LLP
60 State Street
Boston, MA 02109
Tel.: (617) 526-6564
Fax: (617) 526-5000